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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/564,458	01/12/2006	Annaliesa S. Anderson	21569YP	7338				
210 MERCK P O BOX 2000 RAHWAY, NJ 07065-0907	7590 05/31/2011		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">DEVI, SARVAMANGALA J N</td></tr></table>		EXAMINER		DEVI, SARVAMANGALA J N	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**MAY 3 1 2011**

MERCK  
P O BOX 2000  
RAHWAY NJ 07065-0907

In re Application of: :  
Anderson et al. :  
Serial No.: 10/564,458 : PETITION DECISION  
Filed: January 12, 2006 :  
Attorney Docket No.: 21569YP :

This is in response to the petition under 37 CFR § 1.181, filed May 13, 2011, requesting that the finality of the Office action of April 13, 2011 be withdrawn.

BACKGROUND

Only the Office action(s) pertinent to the petition will be discussed herein.

The examiner mailed a final Office action on April 13, 2011 setting a three month statutory limit for reply. At the time of this final Office action, claims 1, 4-9, 33-36 and 38-54 were pending. The examiner rejected claims 1, 4, 7-9, 33-35 and 38-54 and objected to claims 5, 6 and 36. Claims 1, 4, 7, 33 and 49 were rejected under 35 U.S.C. § 102(a) as being anticipated by Roche et al. (Microbiology 149: 643-654, March 2003 - Applicants' IDS) as evidenced by the IDS document 'Opposition against European Patent No. 1651166 in the name of Merck Sharp & Dogme Corp.- Applicants' IDS) and Applicants' admitted state of the prior art. Claims 8, 9 and 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roche et al. (Microbiology 149: 643-654, March 2003 - Applicants' IDS) in view of Foster et al. (US 2003/0186275 A 1) ('275). Claims 7, 8 9 and 38-54 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 4, 7-9, 33-35, 38-44 and 49-51 were rejected under 35 U.S.C. § 112, first paragraph, as containing inadequate written description.

In response thereto, applicants filed this petition on May 13, 2011, requesting that the finality of the Office action of April 13, 2011 be withdrawn.

## DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on May 13, 2011, applicants submit that the finality of the Office action of April 13, 2011 is premature. Applicants argue that "...the April 13, 2011 office action reopening prosecution on the basis of newly cited art, and making the action final, failed to take into account applicants' certification in compliance with 37 C.F.R. § 1.97 (e). Under MPEP § 1207.04 the rejection should not have been made final. MPEP § 1207.04 entitled "Reopening of Prosecution after Appeal [R-8]" provides:

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final **if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed.** See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits. (Emphasis added.)"

More specifically, applicants point out "On January 20, 2011, applicants filed a Communication and Informational Disclosure Statement (IDS) providing the patent office with a copy of an opposition filed on a corresponding European application, a reference cited in the opposition, and the notice of the opposition. Applicants' submission did not include any amendments to the claims. The January 20, 2011 Communication pointed out that the European opposition was filed not more than three month prior to the filing of the IDS, and included copies of the The Notice of Opposition and Opposition statement with dates confirming applicants assertion. The January 20, 2011 IDS included a certification under 37 C.F.R. 1.97, complying with 37 C.F.R. 1.97 (e)(1), by checking off a box indicating the following: the Information Disclosure Statement is filed on or before payment of the issue fee and each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. Authorization is therefore given to charge Deposit Account No. 13-2755 for the fee required under 37 C.F.R. 1.17(p)."

Applicants' argument is well taken and persuasive. Accordingly, in the instant case, it is not proper for the office action to be made final since the January 20, 2011 IDS included a certification under 37 C.F.R. 1.97, complying with 37 C.F.R. 1.97 (e).

## DECISION

The petition is **GRANTED**.

The Office action mailed April 13, 2011 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George Elliott  
Director, Technology Center 1600